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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197289
Party	Plaintiff DC Comics, Marvel Characters, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DC COMICS and MARVEL
CHARACTERS, INC.

Opposers,

v.

SUNNE LAW, P.C.

Applicant.

Opposition No.: 91197289

**OPPOSITION TO APPLICANT’S MOTION TO DISMISS
and
OPPOSITION TO APPLICANT’S MOTION TO STRIKE**

Applicant, Sunne Law, P.C., has not filed a serious motion. Ostensibly presented as a motion to dismiss this proceeding in its entirety under Rule 12(b)(6) or, in the alternative, to strike certain allegations from Opposers’ Notice of Opposition pursuant to Rule 12(f), Applicant’s “motion” is actually just a platform for Applicant to argue why it believes that registration should not be refused. In fact, Applicant does not even discuss, let alone *apply*, the relevant statutory law to the issues at hand, nor has it cited a single case in support of its position. Applicant’s “motion” (such as it is) is not well founded and should be summarily denied.

BACKGROUND

Opposers, DC Comics and Marvel Characters, Inc., jointly own and use the SUPER HEROES® mark, along with variants thereof, for drawn and animated characters, as well as for goods and services associated therewith. *See Not. of Opp.*, ¶¶ 5-6. The SUPER HEROES® mark has been used by Opposers and their licensees since at least as early as 1958, and has, as a result

of such use and due to Opposers' extensive and long-term advertising and promotional efforts, become one of the most famous trademarks used for comic books, clothing, toys, foods, and other products and services. *See id.*, ¶¶ 5, 7-10. Opposers also own several incontestable federal registrations covering their use of the SUPER HEROES® mark for a variety of goods, *see id.*, Ex. A, providing Opposers with both broad and deep trademark rights.

Notwithstanding Opposers' prior rights in SUPER HEROES®, Applicant, Sunne Law, P.C., seeks to register the mark SUPERHERO LAWYERS (with "LAWYERS" disclaimed) as a mark for "legal services." *See* U.S. Serial No. 77895152. Applicant claims to have used the mark at issue since October 2009. *See id.* By way of this proceeding, which was initiated in November 2010, Opposers have objected to that application, arguing that registration and use of SUPERHERO LAWYERS for the subject services would cause confusion with, and dilute the distinctive quality of, Opposers' famous SUPER HEROES® mark. *See Not. of Opp.*, ¶¶ 12-21.

Applicant now moves to dismiss Opposers' claims under Federal Rule 12(b)(6), suggesting that Opposers have failed to state a claim upon which relief may be granted. *See App. Mot.*, p. 1. Alternately, Applicant suggests that certain allegations of Opposers' Notice of Opposition should be struck because they allegedly are "baseless, frivolous, unfounded, defamatory" and, for good measure, "scandalous." *See id.*, pp. 3-4. As will be discussed, however, it is Applicant's motion that is baseless and unfounded (albeit thankfully not "defamatory" or "scandalous"). After all, far from properly applying the appropriate legal standard to the facts of this case, Applicant does not even *discuss* the standard that should be applied. Had Applicant done so, it too would have seen that its motion lacks any merit.

ARGUMENT

A. Opposers Have Properly Alleged Claims for Confusion and Dilution

To set forth a properly pleaded ground for opposition, “[an] opposer need only allege in its ... pleading such facts as would, if proven, establish both its standing to challenge applicant's right to registration and a ... statutory ground for opposition to the application.” *Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha Opposition*, 26 USPQ2d 1503, 1506 (TTAB 1993) (emphasis removed); *see also, e.g., Flash & Partners S.P.A. v. I. E. Manufacturing LLC*, 95 USPQ2d 1813, 1815 (TTAB 2010). “Dismissal under Fed. R. Civ. P. 12(b)(6) is appropriate only if ‘it appears to a certainty that [a party] is entitled to no relief under any state of facts which could be proved in support of the claim.’” *Flash & Partners*, 95 USPQ2d at 1815 (quoting *Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 189 USPQ 420, 422 (CCPA 1976)).

In the present case, Opposers allege that both confusion and dilution are likely to result from Applicant’s registration and use of the subject mark. *See generally Not. of Opp.*, ¶¶ 12-21. To state a proper claim for confusion, Opposers were required to allege in their Notice of Opposition that (1) they had “priority of use” and (2) a “likelihood of confusion” would result. *Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1420 (TTAB 2008); *see also* 15 USC § 1052(d). Meanwhile, to set forth grounds for opposition based on dilution, Opposers needed to allege that (1) their SUPER HEROES[®] mark is “famous”; (2) the SUPER HEROES[®] mark “became famous prior to the date of the application to register the applicant's mark”; and (3) “applicant's mark is likely to blur the distinctiveness of [opposers'] famous mark.” *National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1494-95 (TTAB 2010); *see also* 15 USC § 1125(c)(1).

There can be no question, though, that Opposers have properly asserted both causes of action here. *See, e.g., Not. of Opp.*, ¶¶ 6 (alleging priority of use), 7-10 (alleging that the SUPER HEROES® mark achieved “fame” prior to Applicant’s filing date), 11 (alleging standing), 12-13 (alleging a likelihood of confusion), 20 (alleging injury), 21 (alleging a likelihood of dilution). In fact, Applicant does not even claim that Opposers have failed to assert proper causes of action. *See App. Br.*, pp. 2-3. Instead, Applicant simply makes an inappropriate (and erroneous) analysis concerning the marks and goods and services at issue, and attempts to suggest that because Applicant (not surprisingly) does not believe that confusion or dilution is likely, the Notice of Opposition should be dismissed. *See id.* Obviously, however, that is not the law.

Opposers have real concerns that Applicant’s registration and use of Opposers’ SUPER HEROES® mark are likely to cause consumer confusion or mistake and dilute the distinctiveness of Opposers’ mark. Acting on those concerns, Opposers initiated this action by filing the Notice of Opposition, in which Opposers properly allege causes of action under both Section 2(d) and Section 43(c) of the Trademark Act. As Applicant has not asserted any valid legal reason for why those claims should not be allowed to move forward, the present motion should be denied.

B. Opposers’ Allegations Are Neither “Immaterial” Nor “Impertinent”

It is well settled that motions to strike material from a pleading pursuant to Federal Rule 12(f) “are not favored,” and that matter claimed by the movant to be objectionable “will not be stricken unless such matter clearly has no bearing upon the issues in the case.” *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (citing authority). As the Board has explained, because “[t]he primary purpose of the pleadings ... is to give fair notice of the claims or defenses asserted[,] ... the Board, in its discretion, may decline to strike even objectionable

pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.” *Id.* (citations omitted).

Here, Applicant claims that evidence showing the context of how it has used the subject SUPERHERO LAWYERS mark in commerce is supposedly “immaterial” and somehow “impertinent.” *See App. Br.*, pp. 3-4 (referring to Paragraphs 14-19 and Exhibit C of the Notice of Opposition). For good measure, Applicant also claims that Opposers’ statement that they would likely be injured as a result of consumer confusion because “any objection or fault found with Applicant’s services would necessarily reflect upon and seriously injure” Opposers’ reputation (*Not. of Opp.*, ¶ 20) is not only “frivolous,” but somehow “defamatory[] and scandalous.” *App. Br.*, p. 4. Applicant, however, has no basis for its hyperbolic complaints.

As to Opposers’ inclusion of evidence showing the context in which Applicant is using the subject SUPERHERO LAWYERS mark, it taxes the mind to imagine how references to Applicant’s specimen of use (*Not. of Opp.*, ¶ 15) and/or its publicly-available website (*id.*, ¶ 16 – 19, Exs. C-D) can be seen by Applicant as objectionable, let alone prejudicial. *Cf. Ohio State*, 51 USPQ2d at 1292. More fundamentally, though, this evidence shows that Applicant, when selecting and adopting the SUPERHERO LAWYERS mark, intended to associate itself with Opposers’ SUPER HEROES® brand and related brand imagery. *Accord id.*, ¶ 19 (alleging that “[t]he use of these infringing characters constitutes further evidence of Applicant’s bad faith intent to trade off of the good will developed by Opposer in its ... marks, and of Applicant’s efforts to sow confusion among consumers”). And in view of the fact that evidence of an applicant’s intent to associate itself with the senior party’s mark is relevant both to the strength of the senior mark and to consideration of dilution, *cf., e.g., Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 4 USPQ2d 1541, 1547 (2nd Cir. 1987) (considering defendant’s

copying of plaintiff's mark to be the "most persuasive" factor supporting secondary meaning), *overruled on other grounds, Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 27 USPQ2d 1189 (2nd Cir. 1993); *National Pork Board*, 96 USPQ2d at 1498 (an applicant's selection of its mark with the intent of creating an association with the famous mark supports a finding that dilution by blurring is likely, even if the applicant did not act in bad faith), this evidence is not only far from "immaterial" or "impertinent," it is actually highly relevant.

Similarly, Applicant's reflexive (and highly defensive) objection (*App. Br.*, p. 4) to Opposers' statement in Paragraph 20 that "any objection or fault" that consumers might associate with Applicants' SUPERHERO LAWYER services would reflect negatively on Opposers (or their mark) is unfounded. To begin with, although Applicant may have many satisfied clients, it is a bit presumptuous to suggest that no consumer would ever find *any* "objection or fault" with either its services or the quality of its work product. Moreover, just because the subject services are "legal services" (rather than, say, "retail store services") does not mean that reputation injury caused by misplaced consumer dissatisfaction is not still a legitimate trademark concern.

Opposers' allegations are proper and help explain why Applicant's registration and use of SUPERHERO LAWYERS for "legal services" is likely to cause consumer confusion with, as well as dilute the distinctiveness of, Opposers' famous SUPER HEROES[®] mark, all to Opposers' injury. As Applicant has not set forth any cognizant reasons for their exclusion, the subject allegations should therefore not be struck. *Accord Ohio State*, 51 USPQ2d at 1292.

CONCLUSION

For the reasons stated above, Opposers, DC Comics and Marvel Characters, Inc., respectfully request that Applicant's motions be denied and this case be allowed to proceed.

Respectfully submitted,

Date: February 1, 2011

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing *Opposers' Opposition to Applicant's Motion to Dismiss* and *Opposers' Opposition to Applicant's Motion to Strike* was served on the counsel or parties indicated below on the date and in the manner indicated:

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